

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of	:	Kwok Pun Lee, et al.
	:	
For	:	PARALLEL AND SYNCHRONIZED
	:	DISPLAY OF AUGMENTED
	:	MULTIMEDIA INFORMATION
	:	
Serial No.:	:	09/818,715
	:	
Filed	:	March 27, 2001
	:	
Art Unit	:	2178
	:	
Examiner	:	Thu V. Huynh
	:	
Att. Docket	:	US010071
	:	
Confirmation No.	:	1324

REQUEST FOR RECONSIDERATION

Mail Stop AF Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Request is in response to the Office Action dated September 11, 2006, and is believed to be fully responsive to each point of the rejection raised therein. Accordingly, favorable reconsideration and allowance of all the claims are respectfully requested in view of the following remarks.

Claims 1-4, 6-11, 13 and 14 are pending in the present application of which claims 1 and 8 are independent. Applicant notes that the Office Action Summary and paragraph 2 on page 2 of the Office Action inadvertently omit claim 14 as a claim that is pending in the Application. However, Applicant notes that the first paragraph in section 5 at the bottom of page 2 and the

paragraph bridging pages 10 and 11 both correctly acknowledge claim 14 as pending in the Application.

REJECTION UNDER 35 U.S.C. § 103

The Office Action rejects claims 1-4, 6-11 and 13-14 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Clunie "DICOM Structured Reporting", copyright 2000, pages 7-13, 31, 237 306-314, 325-344, in view of U.S. Patent Publication No. 2002/0049790 to Ricker et al. (hereinafter "Ricker"). Applicant respectfully traverses this rejection.

Claims 1 and 8 are directed, respectively, to a method and a system for transforming a DICOM-SR document into an XML document. Claim 1 recites, *inter alia*, "wherein the mapping of each DICOM attribute into a corresponding XML element is independent of the XML document-type-definition of the XML document." Claim 8 has similar recitations.

As correctly conceded by the Office Action, Clunie does not disclose, teach or suggest the mapping of each DICOM attribute into a corresponding XML element is independent of the XML DTD, as recited in claim 1 and similarly recited in claim 8. See pg. 4-5 of the Office Action. The Office Action relies upon a second reference, Ricker, for this subject matter. However, the Office Action does not provide any suggestion or motivation in the references themselves to modify and/or combine said references. See Office Action, page 4. Rather, the Office Action attempts to substitute facts within the personal knowledge of the Examiner for a motivation or suggestion to combine within the references themselves. *Id.*

It is impermissible for an Examiner to engage in hindsight reconstruction of the prior art using Applicant's claims as a template and selecting elements from references to fill the page. Rather, prior art references may be modified or combined to render obvious a subsequent invention only if there was some suggestion or motivation to do so derived from the prior art itself, the nature of the problem to be solved, or the knowledge of one of ordinary skill in the art. *Sibia Neurosciences*, 225 F.3d 1349, 1356 (Fed. Cir. 2000); *ATD Corp. v. Lydall, Inc.*, 159 F.3d 534, 546 (Fed. Cir. 1998).

"The factual inquiry whether to combine references must be thorough and searching." *In re Sang Su*, 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002) (quoting *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351-52, 60 USPQ2d 1001, 1008 (Fed. Cir. 2001)). Here, it does not appear that the Examiner has conducted the requisite "thorough and searching" factual inquiry. Rather, the Examiner has made no indication whatsoever of where a teaching or suggestion appears in the prior art references that they be combined in the manner necessary to result in the subject matter according to the combinations recited in the rejected claims. The "factual question of motivation [to combine references] is material to patentability, and [can] not be resolved on subjective belief and unknown authority." *In re Sang Su*, 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002).

Here, it appears that the Examiner improperly relies on the Examiner's own "subjective belief and unknown authority" to establish the motivation to combine references essential to an obviousness inquiry. In other words, the Examiner attempts to substitute facts within the personal knowledge of the Examiner for a reference showing the asserted motivation to combine

the references. Applicant respectfully submits that this is improper for at least the following reasons.

According to 37 C.F.R. § 1.104(d)(2), discussed and cited in M.P.E.P. § 2144.03, the Examiner is required to submit an affidavit supporting the facts of which the Examiner relies upon within the Examiner's own knowledge, subject to contradiction or explanation by the Applicant and other persons. Applicant requests such an affidavit.

Applicant respectfully asserts that only by the impermissible use of hindsight knowledge of Applicant's own disclosure would the Examiner have acquired a motivation to combine the teachings of the cited references according to the precise combination including certain elements and excluding certain others as necessary to achieve the subject matter according to the combinations recited in the rejected claims.

It is therefore submitted that claim 1, and consequently also claim 8, which is directed to a system comprising means adapted to perform the method recited in claim 1, are not obvious over the cited art references. Accordingly, reconsideration and withdrawal of their rejections is respectfully requested.

It is submitted that claims 2-4, 6 and 7 are also allowable because they ultimately depend from claim 1, which is allowable over the cited art references based upon the above arguments. Accordingly, reconsideration and withdrawal of their rejections is respectfully requested.

It is also submitted that claims 9-11, 13 and 14 are also allowable because they ultimately depend from claim 8, which is allowable over the cited art references based upon the above

arguments. Accordingly, reconsideration and withdrawal of their rejections is respectfully requested.

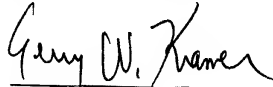
CONCLUSION

In view of the foregoing, withdrawal of the rejections of record and allowance of this application are earnestly solicited.

While we believe that the instant amendment places the application in condition for allowance, should the Examiner have any further comments or suggestions, it is respectfully requested that the Examiner telephone the correspondence attorney listed below in order to expeditiously resolve any outstanding issues.

In the event that the fees submitted prove to be insufficient in connection with the filing of this paper, please charge our Deposit Account Number 50-0578 and please credit any excess fees to such Deposit Account.

Respectfully submitted,
KRAMER & AMADO, P.C.



Terry W. Kramer
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Date: November 8, 2006

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